

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK**

\_\_\_\_\_  
Advantus Capital Management, Inc., )  
(a Minnesota Corporation), )  
 )  
 )  
Plaintiff, )  
 )  
v. )  
 )  
Advantus Global, Inc. )  
(a New York Corporation), )  
 )  
Defendant. )  
\_\_\_\_\_

Civil Action No. 16-cv-7161

**JURY TRIAL DEMANDED**

**COMPLAINT**

Plaintiff Advantus Capital Management, Inc., by way of its complaint against the Defendant, states and alleges as follows:

**THE PARTIES**

1. Plaintiff Advantus Capital Management, Inc. (“Advantus”) is a Minnesota Corporation having its principal place of business at 400 North Robert Street, St. Paul, MN 55101.

2. Defendant Advantus Global, Inc. (“AGI”) is a New York Corporation having a place of business at 6 E 39<sup>th</sup> Street, Suite 709 New York, New York 10016 as reflected in the records of the New York Secretary of State’s office. AGI also has an address at 165 Madison Ave. Suite 300, New York, New York, 10016, as reflected on AGI’s web site.

**NATURE OF THIS ACTION**

3. This cause of action arises under the Federal Trademark Act, 15 U.S.C. §§ 1051 - 1127 and New York’s General Business Law §349 (2004) and the common law of New York.

This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331, 1338 and 1367. Venue is proper pursuant to 15 U.S.C. § 1121(a).

**STATEMENT OF CLAIM**

4. Advantus is the owner of United States trademark Registration No. 2,663,467 for the mark ADVANTUS® registered for “mutual fund, investment advisor and asset management services.” The United States Patent and Trademark Office issued the above-mentioned registration in compliance with law on December 17, 2002. A copy of Advantus’ registration, as issued by the United States Patent and Trademark Office is attached hereto as Exhibit “A.” Advantus has, and through its related companies, licensees and affiliates, used the name and mark ADVANTUS to identify itself and its various business services since at least as early as October 24, 1994, and continuously thereafter up to and including the present time. Advantus has expended considerable resources in developing its ADVANTUS services and products, and its reputation. Advantus’ investment advisory services and mutual funds are well known and held in high regard. Advantus markets and sells asset management services under the ADVANTUS mark to a wide variety of clients and customers, including but not limited to institutional investors, government entities, corporations, registered investment companies, life and health insurance companies, property and casualty insurers, employers, retail investors, hedge funds, financial institutions, banks, investment consultants, pension plans, municipalities, non-profits, fraternal associations, and others. Advantus also offers a portfolio of mutual funds that are available to be purchased by institutions and investors, hedge funds, and by individual retail investors in connection with the name and trademark ADVANTUS. Advantus is the advisor for the Advantus Mutual Funds including, ADVANTUS DYNAMIC MANAGED VOLATILITY FUND, ADVANTUS MANAGED VOLATILITY EQUITY FUND,

ADVANTUS SHORT DURATION BOND FUND, ADVANTUS STRATEGIC DIVIDEND INCOME FUND, ADVANTUS REAL ESTATE SECURITIES, ADVANTUS ULTRA SHORT DURATION FIXED INCOME, ADVANTUS SHORT DURATION FIXED INCOME, ADVANTUS LONG DURATION FIXED INCOME, ADVANTUS STRATEGIC DIVIDEND INCOME STRATEGY. Advantus sub-advises funds for other unaffiliated investment companies and, through the Securian Funds Trust, Advantus manages 13 funds offered in certain variable life insurance and annuity contracts.

5. Advantus also currently offers its wide variety of fund strategies and services using the name and trademark ADVANTUS, including the SFT ADVANTUS INDEX 500 FUND, SFT ADVANTUS INTERNATIONAL BOND FUND, SFT ADVANTUS DYNAMIC MANAGED VOLATILITY FUND, SFT ADVANTUS MANAGED VOLATILITY EQUITY FUND, SFT ADVANTUS GOVERNMENT MONEY MARKET FUND, SFT ADVANTUS MORTGAGE SECURITIES FUND, SFT ADVANTUS REAL ESTATE SECURITIES FUND, all including the ADVANTUS name and trademark. Many employers offer one or more of these ADVANTUS funds and strategies as an option for individuals to invest some or all of their investment dollars as part of the individual's investments for retirement, as part of a pension, 401(k) or other retirement plan. These funds and strategies are also presented by registered financial advisors to individuals, and others, as permitted by law.

6. Advantus operates an internet web page to promote its services, and to provide information and details about its services to the public at the domain address [www.advantusfunds.com](http://www.advantusfunds.com). A portion of the current webpage operated by Advantus is attached hereto as Exhibit "B". Exhibit "B" lists the average annual returns of four different composite investment funds advised under the ADVANTUS trademark by Advantus as of June 30, 2016.

Exhibit “C” attached hereto is a published summary description of the Advantus Mutual Funds as published on one of the websites of Advantus. Advantus acts as an advisor, or sub-advisor to its investors and customers, and Advantus has a duty to protect the name and reputation of ADVANTUS. Advantus describes its services as providing “powerful insights and exceptional relationships.” In connection with its investment advisory services Advantus also performs investment transactions on behalf of its clients where it regularly interacts with law firms, private equity firms, hedge funds, investment banks, and financial institutions. The history of growth and success Advantus has had under the ADVANTUS mark is summarized on Exhibit “F” attached hereto. Advantus has continuously expanded its offerings under the mark by adding new investment portfolios, funds, and strategies over the years. The total value of assets either managed or sub-advised by Advantus today stands at approximately thirty five billion dollars (\$35,000,000,000.00).

7. Since at least as early as 1995, Advantus has been commercially using the ADVANTUS mark in connection with its business activities in interstate commerce. Since about 2003, Advantus has given notice of its registered rights in the ADVANTUS mark by using the ® symbol.

8. Advantus has expended a substantial amount of money and effort in advertising and promoting the ADVANTUS names and marks and its related investment advising and other products and services. Advantus’ substantial promotional, advertising, publicity, and public relations activities further promote the recognition and goodwill associated with the ADVANTUS names and marks. These activities include promotion in print media, on the Internet at [www.advantuscapital.com](http://www.advantuscapital.com) and at [www.advantusfunds.com](http://www.advantusfunds.com), and in presentations of numerous kinds to business prospects and customers. Advantus works with sales personnel,

distribution channels, and registered representatives authorized to offer its products and services to individuals and others both nationwide and internationally. Globally, Advantus participates in private placement bond deals and private equity transactions on behalf of its clients. In connection with those services, it regularly interacts with law firms, investment banks, private equity firms, financial services firms, and hedge funds.

9. Advantus has previously been forced to test its ADVANTUS mark in court proceedings. In 2006, the United States District Court for the District of Minnesota ruled in Advantus' favor on a Preliminary Injunction motion, holding, among other things, that Advantus' ADVANTUS mark was strong, was "a coined or invented word – one not found in the dictionary," and one whose 'inherent novelty creates a substantial impact on the buyer's mind.' *Advantus Capital Management Inc. and Advantus Series Fund, Inc. v. Aetna* (p. 4-5 Oct. 11, 2006 Order, 06-cv-2855, D. Minn.) A copy of this Order is attached hereto as Exhibit "D."

#### **AGI'S UNLAWFUL ACTIVITIES**

10. Unbeknownst to Advantus, AGI was incorporated by the State of New York, with a corporate formation filing made on July 21, 2011 under DOS ID # 4141470. Thereafter, AGI began using the names and trademarks ADVANTUS and ADVANTUS GLOBAL and ADVANTUS GLOBAL, INC.

11. On or about April 15, 2011 AGI obtained the internet domain name [advantusglobal.com](http://advantusglobal.com) and established the webpage and web site [www.advantusglobal.com](http://www.advantusglobal.com) in order to communicate with customers and others and do business on the worldwide web.

12. According to AGI's website:

*AGI is a knowledge broker of expertise and insight. Started by Harvard and Stanford alumni, AGI's management team stems from the same training as many of its users. It was founded on the idea that expertise and information should be shared through an understanding of limitations. We provide clients with "hard to find" expertise that*

*enhances their research process. We partner with our clients thereby eliminating high fees and passing along substantial savings.*

*Combining the expert networks of Business Connect China, Circle of Experts, and Tribeca Insights, Advantus Global aims to be the largest source of global leading experts across all industries-executives, scientists, academics, consultants, and regulatory observers who can deliver fast and precise solutions to client issues through private telephone consultations, customized surveys, and in-person meetings. We pride ourselves on quick, efficient turnaround times for clients and a deep, vast repository of experts all around the world.*

*We pride ourselves on:*

- 1. Providing the highest quality and most relevant experts according to client needs in minimum time frame*
- 2. Carefully recruiting and managing quality experts and assembling them into a network for intelligence and knowledge*
- 3. Enforcing the strictest compliance standards to protect our clients and experts*
- 4. Offering the most cost effective solutions for global or regional projects.*

A copy of this portion of the AGI web page is attached hereto as Exhibit "E."

13. The AGI web site describes its field of operation with these words:

*In an ever interconnected world, investment firms, corporations, and professional services firms increasingly rely on primary research to gain valuable insights for critical business decisions.*

*AGI provides the breadth and depth of expertise, as well as the flexibility in process, necessary to serve even your most demanding project needs in the shortest possible time.*

and describes its clients as "some of the top consulting firms, financial services firms, law firms, leading corporates, and academic and non-profit groups globally."

14. AGI uses this illustration of its customers on its web site:



**THE IMPACT OF AGI'S CONDUCT ON ADVANTUS  
AND THE MARKETPLACE**

15. Advantus has long used its ADVANTUS mark with Private Equity, Corporate Clients, Investment Banks, Consulting Firms, Financial Services Firms, Law Firms, Corporations, and Hedge Funds.

16. The markets for Advantus' and Defendant's products and services sold under the ADVANTUS marks at issue are the same, or have significant overlap, in many instances involving identical or closely related customers. Moreover, as Advantus and Defendant expand their activities, the overlap will only increase. For example, should Advantus decide to offer an investment fund composed of assets based outside of the United States, the fund name ADVANTUS GLOBAL FUND would be a natural and logical choice for such a new fund. Customers and potential customers are likely to believe the same company markets both Advantus' products and services including their advising, consulting and investment services, and Defendant's products and services including its advising, researching, consulting and "expert" services.

17. Defendant's marketing efforts and business activities, as well as its current and intended use of the mark ADVANTUS are in violation of Advantus' rights. The domain name [advantusglobal.com](http://advantusglobal.com) falsely suggests that the web page displayed at [www.advantusglobal.com](http://www.advantusglobal.com) comes from, or is affiliated with or sponsored by Advantus when it is not. All marketing statements on this web page would be presumed to come from Advantus when they do not.

18. Defendant has been made aware of the Advantus' prior rights and federal trademark registration by letter requesting that it cease use of the ADVANTUS name and, to date, Defendant has refused to cease and desist from its use of the confusingly similar and deceptively similar names and trademarks to those long used by Advantus. In addition, Defendant has constructive notice of Advantus' rights, through Advantus' federal registration, and through Advantus' use of the ® symbol in connection with the ADVANTUS mark since about 2003. Despite such actual and constructive notice, Defendant has refused to cease and desist from its current use.

19. The activities of Defendant are likely to create confusion in the marketplace and are likely to deceive decision makers, institutional investors, retail investors, consultants, law firms, investment banks, private equity firms, financial service firms, hedge funds, and others who are likely to falsely believe the Defendant's services come from, are approved by, are a line extension of, or are managed by Advantus. The activities of Defendant are outside the control of Advantus and place at risk the significant investment and reputation of Advantus in the name and mark ADVANTUS. The potential harm should negative news or results about Defendant arise is enormous and irreparable.

20. The "Advantus" name and mark as used by Advantus and the names and marks "Advantus" and "Advantus Global" as used by Defendant, are identical or confusingly similar, in

appearance, pronunciation, and meaning. The trademarks of the parties are confusingly similar and deceptively similar. The parties operate in the same or closely related fields.

**COUNT I**  
**FEDERAL TRADEMARK INFRINGEMENT**  
**15 U.S.C. §114**

21. Advantus repeats and realleges paragraphs 1-20.

22. Advantus owns the ADVANTUS trademark and the certificate of registration thereof is *conclusive* evidence of its ownership of the mark, the validity of the registration, and its exclusive right to use that mark in commerce with respect to the services of mutual funds, investment advising, and asset management services by operation of law because the registration has become incontestable under 15 U.S.C. §§1065 and 1115(b).

23. Defendant has used in commerce, and is continuing to use with knowledge of Advantus' rights a mark or marks confusingly similar to the Advantus' federally-registered mark, in connection with the advertising, promotion, and/or sale of their products and services. The mark ADVANTUS as used by Defendant is identical to Advantus' ADVANTUS mark. The mark ADVANTUS GLOBAL is confusingly similar to the ADVANTUS mark, and differs only by the addition of GLOBAL, which is not distinguishing since both parties have a business operating in commerce with a broad reach. Defendant provides closely related products and services to those of Advantus to the same or closely related customers to Advantus' current and future customers without the consent of Advantus in a manner that is likely to cause confusion, to cause mistake, or to deceive as to source or origin among purchasers and/or users of those products and services.

24. Defendant's actions constitute trademark infringement under 15 U.S.C. § 1114.

25. Defendant's actions are being taken in a negligent, or grossly negligent manner, or in a willful, deliberate, or intentional plan in disregard of Advantus' rights. This case is exceptional under the Lanham Act.

26. Advantus has been damaged by the actions of Defendant, and Defendant is likely to profit in an amount that is undetermined, but believed to be in excess of \$100,000. Advantus is suffering and will suffer irreparable injury for which it has no adequate remedy at law.

**COUNT II**  
**FEDERAL UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN**  
**15 U.S.C. §1125(a)**

27. Advantus repeats and realleges paragraphs 1-26.

28. Advantus also has common law rights in the ADVANTUS names and marks.

29. The cause of action set forth herein arises under the Lanham Act of the United States, 15 U.S.C. §§ 1051-1127.

30. Defendants' acts constitute false designations of origin and misrepresentations in violation of 15 U.S.C. § 1125(a), causing damage and injury to Advantus, and Advantus is suffering and will suffer irreparable harm and injury for which Advantus has no adequate remedy at law.

**COUNT III**  
**TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION**  
**UNDER COMMON LAW**

31. Advantus repeats and realleges paragraphs 1 - 30.

32. This cause of action arises under the common law of New York.

33. Defendant's activities complained of constitute trademark infringement and unfair competition in violation of Advantus' rights under the common law of the State of New York.

**COUNT IV**  
**DECEPTIVE ACTS AND PRACTICES**

**N.Y. GEN. BUSINESS LAW §349 (2004)**

34. Advantus repeats and realleges paragraphs 1-33.

35. Defendant's activities complained of constitute deceptive acts and practices in the conduct of Defendant's business, trade or commerce all in violation of N.Y. Gen. Bus. Law §349 (2004).

**COUNT V**  
**COMMON LAW MISAPPROPRIATION**

36. Advantus repeats and realleges paragraphs 1-35.

37. Defendant's activities complained of constitute misappropriation by Defendant to improperly use and benefit from the valuable goodwill, reputation and business property of Advantus in violation of Advantus' rights under the common law of the State of New York.

**JURY TRIAL DEMANDED**

Advantus hereby demands a trial by jury under Federal Rule of Civil Procedure 38.

WHEREFORE, Advantus prays that the Court enter an order:

A. Preliminarily, and then permanently enjoining and restraining the Defendant, its members, managers, directors, officers, agents, servants, employees, subsidiaries, affiliates, and all persons in active concert or participation with, through, or under Defendants, at first during the pendency of this action and thereafter perpetually:

1. From infringing Advantus' trademark ADVANTUS and/or committing any acts of unfair competition and/or from implying a false designation of origin or a false description or representation with respect to Advantus' mark ADVANTUS;

2. From committing any acts of unfair competition by passing off or inducing or enabling others to sell or pass off goods/services which are not Advantus' goods/services as those of Advantus;

3. From using in any manner advertising, marketing materials, investors materials prospectus documentation, offerings, placements, expert reports, recommendations, advice or filings with governmental agencies, or other materials related to the Defendant's services, bearing the word ADVANTUS and any other mark, word, or name confusingly similar to Advantus' mark ADVANTUS;

4. From making any statements on promotional materials or advertising for the Defendant's services, on the internet, in marketing material, or in commerce, which are false, confusing or misleading as to source or origin, including removing the domain name advantusglobal.com from the internet; and

5. From committing any acts of deceptive or unlawful trade practices calculated to cause members of the trade or purchasing public to believe that Defendant's goods/services are the goods/services of Advantus or sponsored by or associated with, or related to, or connected with, or in some way endorsed or promoted by Advantus, or are under the supervision or control of Advantus.

B. An order requiring that the Defendant deliver up to Advantus any and all containers, signs, packaging materials, printing plates, stationery, and advertising or promotional materials and any materials used in the preparation thereof, which in any way unlawfully use or make reference to ADVANTUS in connection with Defendant's services, and abandoning the domain name advantusglobal.com.

C. An order requiring that Defendant, within thirty (30) days after service of notice of entry of judgment or issuance of an injunction pursuant thereto, file with the Court and serve upon the Advantus' counsel a written report under oath setting forth details of the manner in which Defendant has complied with the Court's order pursuant to paragraphs A and B above.

D. An order requiring Defendant to account and pay over to Advantus all damages sustained by Advantus, Defendant's profits, Advantus' attorneys fees, and costs, and ordering that the amount of damages awarded Advantus be increased three times the amount thereof.

E. Awarding Advantus such other relief as the Court may deem just and proper.

Advantus Capital Management, Inc.

By its attorneys,

Date: September 13, 2016

By /s/ Keith E. Sharkin  
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